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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,977	01/31/2001	Michael D. Whitmarsh	10003963-1	6668

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 10/07/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/773,977

**Applicant(s)**

WHITMARSH, MICHAEL D.

**Examiner**

Saeid Ebrahimi-dehKordy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 7-13 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubayashi et al (EP 1109113 A2) in view of Scanlan (U.S. patent 6,029,245)

Regarding claim 1 and 36 Matsubayashi et al disclose: A method for use in utilizing a print service (please note Fig.1 as the files or document is send from the computer through the internet to the printer, column 5 lines 1-13) the method comprising: receiving a print request at a local client computing device (please note column 6 lines 51-58 and column 7 lines 1) and displaying a remotely served print interface on the local client computing device (please note column 7 lines 2-27 where the URL is used as the print interface to deliver the print data to the printer in the internet or external printer) However Matsubayashi et al do not quite teach the: the print interface being configured to request a printing parameter relating to the print request. On the other hand Scanlan discloses: the print interface being configured to request a printing parameter relating to the print request (please note column 6 lines 32-38).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Matsubayashi et al's invention according to the teaching of Scanlan, Where Scanlan in the same field of endeavor teaches the way the web page

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or (file) could be transferred with the parameters from the web server to the user's browser for the purpose of making the file transfer more efficient.

Regarding claim 2 Matsubayashi et al disclose: The method of claim 1, wherein the print request is received by an application program executed on the local client computing device (please note column 6 lines 53-56).

Regarding claim 7 Matsubayashi et al disclose: The method of claim 1, wherein the local client computing device includes a client initialization program the method further comprising, in response to receiving the print request, opening a connection between the client initialization program and a workflow application server at a predetermined workflow application server address (please note column 6 lines 51-60)

Regarding claim 8 Matsubayashi et al disclose: The method of claim 7, further comprising, downloading a repository address from the workflow application server (please note column 6 lines 51-55).

Regarding claim 9 Matsubayashi et al disclose: The method of claim 8, further comprising, uploading a printable file corresponding to the print request to a repository at the repository address (please note column 7 lines 10-17).

Regarding claim 10 Matsubayashi et al disclose: The method of claim 7, further comprising, downloading a user interface address from the workflow application server (please note column 5 lines 50-57 and column 6 lines 1-12).

Regarding claim 11 Matsubayashi et al disclose: The method of claim 10, wherein the remotely served print interface is served from the user interface address (please note column 5 lines 41-58 and column 6 lines 1-2).

Regarding claim 12 Matsubayashi et al disclose: The method of claim 7, wherein the client initialization program is called by a print service print driver (please note column 8 lines 43-50).

Regarding claim 13 Scanlan disclose: The method of claim 1, further comprising, receiving via the print interface a printing parameter relating to the print request (please note column 6 lines 32-38).

***Claim Rejections - 35 USC § 103***

3. Claims 3-6, 14-18 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubayashi et al (EP 1109113 A2) in view of Scanlan (US. Patent 6,029,245) and further in view of Wood et al (U.S. patent 6,453,127)

Regarding claim 3 Neither Matsubayashi et al nor Scanlan quite disclose: The method of claim 2, further comprising, after receiving the print request via the application program, displaying a print dialog menu on the local client computing device, the print dialog menu including a remote print service option. On the other hand Wood et al disclose: The method of claim 2, further comprising, after receiving the print request via the application program, displaying a print dialog menu on the local client computing device, the print dialog menu including a remote print service option (please note column 6 lines 1-54). print request (please note column 6 lines 32-38).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Matsubayashi et al's and Scanlan invention according to the teaching of Wood et al, Where Wood et al in the same field of endeavor teaches the

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way the file which is being transmitted to the remote site for printing is displayed by user and edited for the purpose of making the transfer of the job more efficient.

Regarding claim 4 Wood et al disclose: The method of claim 3, further comprising, in response to user selection of the remote print service option, creating a printable file for the print request (please note column 6 lines 35-45).

Regarding claim 5 Wood et al disclose: The method of claim 4, wherein the printable file is created by a print service print driver called by the application program (please note column 5 lines 54-67).

Regarding claim 6 Wood et al disclose: The method of claim 1, wherein the local client computing device includes a browser (please note Fig.2 items 11 and 20) the method further comprising, after receiving the print request opening the browser to an address from which the print interface is remotely served (please note column 5 lines 54-67 and column 6 lines 1-18).

Regarding claim 14 Wood et al disclose: The method of claim 13, further comprising, sending the printable file from the local client computing device to a remote publisher for printing (please note column 4 lines 15-34).

Regarding claim 15 Wood et al disclose: The method of claim 14, wherein sending the printable file to a remote publisher includes sending the printable file from the local client computing device to a repository (please note column 4 lines 15-33).

Regarding claim 16 Wood et al disclose: The method of claim 15, wherein sending the printable file to a remote publisher further includes sending the printable file from the repository to the remote publisher (please note column 6 lines 8-54).

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Regarding claim 17 Wood et al disclose: The method of claim 14, further comprising, sending the printing parameter from the local client computing device to a remote publisher (please note column 3 lines 20-28).

Regarding claim 18 Wood et al disclose: The method of claim 1, wherein a print service workflow application server remotely serves the print interface to the local client computing device (please note column 2 lines 60-67 and column 3 lines 1-10).

Regarding claim 37 Wood et al disclose: The program storage device of claim 36, wherein the method further comprises sending (1) a printable file corresponding to the print request, and (2) the printing parameter, to a selected remote publisher for printing (please note column 2 lines 60-67 and column 3 lines 1-30).

Regarding claim 38 Wood et al disclose: The program storage device of claim 37, sending the printable file to the remote publisher is accomplished by uploading the printable file to a repository, and downloading the printable file from the repository to the remote publisher (please note column 4 lines 15-50).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 19-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubayashi et al (EP 1109113 A2) in view of Wood et al (U.S. Patent 6,453,127)

Regarding claim 19 Matsubayashi et al disclose: A method for sending a print job to a remote publisher for printing (please note Fig.1 column 2 lines 45-67 and column 3 lines 1-7) the method comprising: receiving a print request at a local client computing device (please note column 6 lines 51-55) creating a printable file in response to the print request (please note column 6 lines 55-58 and column 7 line 1) displaying a remotely served print interface on the local client computing device (please note Fig.7 column 7 lines 5-9 where the path of the printer and the document to be printed is displayed on the user computer) However Matsubayashi et al do not quite teach: requesting and receiving via the print interface a printing parameter relating to the print request; and sending the printable file and the printing parameter to a selected remote publisher for printing. On the other hand Wood et al disclose: requesting and receiving via the print interface a printing parameter relating to the print request (please note column 3 lines 11-31 where the requested parameters could be selected) and sending the printable file and the printing parameter to a selected remote publisher for printing (please note Fig.2 items 11 and 15 where the clients would sent job to the plurality of printers 15, column 4 lines 8-33).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Matsubayashi et al's invention according to the teaching of Wood et al, where Wood et al in the same field of endeavor teach the way the parameters are being requested and combined with the print job is sent to the remote printing system for the purpose of making the transmitting of the print job more efficient.



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Regarding claim 20 Matsubayashi et al disclose: A print service system for use by a user (please note Fig.2 column 4 lines comprising: a print service workflow application server configured to serve a print interface via a wide area network (please note Fig.7 column 7 lines 2-9) and a local computing device configured to receive a print request from the user and (please note Fig.5 column 6 lines 51-52) in response download and display a print interface from the workflow application server via the wide area network (please note column 6 lines 52-58 and column 7 lines 1) However Matsubayashi do not disclose: wherein the print interface is configured to receive a printing parameter relating to the print request. On the other hand Wood et al disclose: wherein the print interface is configured to receive a printing parameter relating to the print request. On the other hand Wood et al disclose (please note column 3 lines 11-31 where the requested parameters could be selected also please note Fig.2 items 11 and 15 where the clients would sent job to the plurality of printers 15, column 4 lines 8-33). Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Matsubayashi et al's invention according to the teaching of Wood et al, where Wood et al in the same field of endeavor teach the way the parameters are being requested and combined with the print job is sent to the remote printing system for the purpose of making the transmitting of the print job more efficient.

Regarding claim 21 Wood et al disclose: The system of claim 20, wherein the printing parameter is a selected destination remote publisher associated with the print service (please note column 3 lines 20-30).

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Regarding claim 22 Wood et al disclose: The system of claim 20, wherein the local computing device is configured to generate a printable file relating to the print request (please note column 4 lines 35-52).

Regarding claim 23 Wood et al disclose: The system of claim 22, wherein the printable file is a native file (please note column 4 lines 39-45).

Regarding claim 24 Matsubayashi et al disclose: The system of claim 22, wherein the printable file is a printable file generated by a print driver (please note column 8 lines 43-50).

Regarding claim 25 Wood et al disclose: The system of claim 22, further comprising a remote publisher, wherein the local computing device is configured to send the printable file to the remote publisher (please note column 4 lines 15-34).

Regarding claim 26 Wood et al disclose: The system of claim 25, wherein the remote publisher print service workflow application server and local client computing device are configured to communicate via a wide area network (please note Fig.2 column 4 lines 15-52).

Regarding claim 27 Wood et al disclose: The system of claim 25, wherein the workflow application server is configured to cause the printable file and the printing parameter to be sent from the local computing device to the remote publisher (please note column 2 lines 60-67 and column 3 lines 1-30).

Regarding claim 28 Wood et al disclose: The system of claim 25, further comprising a repository configured to store the printable file and the printing parameter (please note column 5 lines 54-67 and column 6 lines 1-30).

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Regarding claim 29 Wood et al disclose: The system of claim 28, wherein the workflow application server is configured to instruct the local computing device to send the printable file to the repository and the remote publisher includes a remote publisher server configured to download the printable file and printing parameter from the repository (please note column 4 lines 15-52).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 30-35 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Wood et al (U.S. Patent 6,453,127)

Regarding claim 30 and 39 Wood et al disclose: A print service system for use by a user, comprising: a local client computing device configured to connect to a wide area network (please note Fig.1 item 11 column 2 lines 49-60) a remote publisher server configured to connect to the wide area network (please note Fig.2 items 15 and 30 column 4 lines 15-33) a repository server and associated database (please note Fig.2 item 30 and 39 column 4 lines 34-52) the repository server being configured to connect to the wide area network; and a print service workflow application server configured to connect to the wide area network (please note Fig.2 column 4 lines 15-65) wherein the

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local client computing device is configured to contact the print service workflow application server in response to receiving a print request and the print service workflow application server is configured to instruct the local client computing device to upload a printable file associated with the print request to the repository server for storage in the repository database (please note Fig.3 column 5 lines 54-67 and column 6 lines 1-67 and column 7 lines 1-19) and wherein the print service workflow application server is configured to instruct the remote publisher server to download the printable file from the repository for printing (please note column 6 lines 35-54).

Regarding claim 31 Wood et al disclose: A print service system utility, comprising a client initialization program configured to establish a connection with a remote commercial print service at a predetermined address on a computer network (please note column 6 lines 35-50).

Regarding claim 32 Wood et al disclose: The print service system utility of claim 31, wherein the client initialization program is configured to download an upload address from the print service (please note column 5 lines 62-67 and column 6 lines 1-4).

Regarding claim 33 Wood et al disclose: The print service system utility of claim 32 wherein the client initialization program is configured to launch an upload module to upload a printable file to the commercial print service (please note column 6 lines 35-45).

Regarding claim 34 Wood et al disclose: The print service system utility of claim 31, wherein the client initialization program is configured to download a user interface

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address from the print service (please note column 5 lines 62-67 and column 6 lines 1-9).

Regarding claim 35 Wood et al disclose: The print service system utility of claim 34, wherein the client initialization program is configured to launch a browser directed at the user interface address, to thereby display a print interface (please note column 4 lines 34-65).

### **Contact Information**

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

#### **Any response to this action should be mailed to:**

Assistant Commissioner for Patents  
Washington, D.C. 20231

#### **Or faxed to:**

(703) 872-9306, or (703) 308-9052 (for **formal** communications; please mark  
"EXPEDITED PROCEDURE")

#### **Or:**

(703) 306-5406 (for **informal** or **draft** communications, please label  
"PROPOSED" or "DRAFT")

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**Hand delivered responses** should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy  
Patent Examiner  
Group Art Unit 2626  
September 28 2004

  
KIMBERLY WILLIAMS  
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